

Sent Via Facsimile Transmission 571.273.8300

PATENT
18061 (AT 20958-2114)**Remarks**

The Office Action mailed October 26, 2005 has been carefully reviewed and the following remarks are made in consequence thereof. Applicants respectfully request reconsideration of the present claim rejections in light of these remarks.

Claims 1-20 are now pending in this application. It is respectfully submitted that the pending claims define allowable subject matter.

The rejection of Claims 1-10, 12-16, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Guitierrez (U.S. Patent No. 6,585,540) in view of Farrar et al. (U.S. Patent No. 4,726,638) is respectfully traversed, and the rejection of claims 11 and 17 as being unpatentable over Guitierrez in view of Farrar et al. and further in view of Belopsky (U.S. Patent No. 6,036,547).

Preliminarily, Applicants wish to respond to Response to Arguments section of the Final Office Action wherein the Examiner states that certain recitations are "not seen to claim any structure that prevents the [Guitierrez et al. reference] from being used for the same function." Applicants respectfully submit that the burden lies on the Patent Office to establish that prior art devices perform functions recited in the claims, and that shifting the burden to Applicants to identify structure in the claims that would prevent or impair a functional attribute of a prior art device is improper and contrary to applicable and controlling law. Applicants also note that the Examiner's assertion that certain recitations of the claims are functional and are not entitled to patentable weight is also improper and contrary to well established law. Under the proper standard of obviousness, it is improper to disregard functional recitations, and the Federal Circuit has repeatedly found that *all* recitations of the claims must be considered, and all recitations of the claims must be disclosed or suggested in the cited to properly reject claims as obvious. Thus,

Sent Via Facsimile Transmission 571.273.8300

PATENT
18061 (AT 20958-2114)

as a matter of procedure, the present claim rejections are not believed to be sustainable and should be reconsidered under the proper standard.

Notwithstanding procedural arguments, however, Applicants note that the structure of the Guterrez et al. device is distinguishable from the present invention on the merits, and that consequently the Guterrez et al. device is incapable of performing the function of the present invention. Specifically, the Final Office Action cites element (260) as corresponding to the recited shield in the instant claims, and cites elements (230) as the recited magnetic components that are connected to the shield.

Contrary to the assertion otherwise in the Final Office Action, the component packages (230), (232) of Guterrez et al. are not directly grounded to a ground plane of a shield as recited in independent claims 1, 9, and 13. Rather, Guterrez et al. disclose component packages (230), (232) having conductor sets (220a) and (220b) in each package. See Guterrez et al. col. 6, lines 63-65. Guterrez et al. also disclose a shield substrate (260) having at least one layer of fiberglass (262) and a metallic shielding layer (266) disposed on the fiberglass (262). See Guterrez et al. col. 8, lines 63-65. The shielding layer (266) and an external noise shield are "ultimately grounded so as to avoid accumulation of electrostatic potential or other potentially deleterious effects." See Guterrez et al. col. 9, lines 12-16. However, Guterrez et al. specifically state that:

[T]he metallic shield layer 266 is etched or removed from the area 270 immediately adjacent the surrounding terminal pins arrays 268, thereby removing any potential for undesirable shorting or conductance in that area. Hence the lower conductors 220b of each connector penetrate the substrate and only contact the non-conductive fiberglass layer 262 of the substrate 260.

Guterrez et al. col. 9, lines 17-24.

It is therefore apparent that the conductors (220b) of the component packages (230), (232) as shown in Figures 2b, 2d and 2f of Guterrez et al. are electrically isolated from, rather

Sent Via Facsimile Transmission 571.273.8300

PATENT
18061 (AT 20958-2114)

than grounded to, the metallic shielding layer (266). The terminals (220b) therefore do not and cannot establish a ground path to the metallic shielding layer (266), and the magnetic components (230), (232) of Guterrez et al. are consequently neither directly grounded nor indirectly grounded to the shielding layer (266).

Because the magnetic components (230), (232) of Guterrez et al. are not grounded to a shield as recited in claims 1, 9, and 13, the Guterrez et al. component packages are incapable of avoiding common impedance coupling and suppressing EMI/RFI in incoming and outgoing signals as recited in claims 1 and 13, and further are incapable of suppressing EMI as recited in claims 1, 9 and 13.

Neither Ferrar et al. nor Belopsky et al. cure the deficiencies of Guterrez et al. with respect to the invention of claims 1, 9 and 13, and claims 1, 9, and 13, together with their respective base claims, are submitted to be patentable over the cited art.

Applicants also note that other differences have been identified in Applicants previous response between the invention of claims 1, 9 and 13 and the teaching of Guterrez et al., Farrar et al. and Belopsky et al. Such differences, considered under the proper standard of obviousness, are also believed to render the inventions of claims 1, 9 and 13 non-obvious over the cited art. Considering the structural and functional differences between the cited art and the present invention Applicants have identified in this response and Applicants previous response, Applicants respectfully request reconsideration and withdrawal of the present claim rejections and request that a Notice of Allowance be issued in the application.

Sent Via Facsimile Transmission 571.273.8300

PATENT
18061 (AT 20958-2114)

Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Bruce T. Atkins
Registration No. 43,476
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070